

ESTTA Tracking number: **ESTTA367129**

Filing date: **09/07/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91169226
Party	Defendant Studio Moderna SA
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Signature	/Eric L. Lane/
Date	09/07/2010
Attachments	Answer_and_Counterclaims.PDF (10 pages)(139424 bytes)

Registration Subject to the filing

Registration No	3237860	Registration date	05/01/2007
Registrant	ARCADIA GROUP BRANDS LIMITED COLEGRAVE HOUSE, 70 BERNERS STREET LONDON, W1T 3NL UNITED KINGDOM		

Goods/Services Subject to the filing

Class 025. First Use: 1964/12/31 First Use In Commerce: 1998/12/31
All goods and services in the class are requested, namely: Women's clothing, namely skirts, dresses, pants, tops and jacket

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 78/239,078
TOP SHOP TV (and design)
International Classes: 10, 20, 24, 35, and 41
Published in the *Official Gazette* of August 23, 2005
and
Registration Serial No. 3,389,652
TOP SHOP TV
International Class: 35
Registered: February 26, 2008

Arcadia Group Brands Ltd.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91169226
)	Cancellation No. 92049146
Studio Moderna SA,)	(as consolidated)
)	
Applicant.)	
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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

**ANSWER AND COUNTERCLAIMS BY
APPLICANT-REGISTRANT AND
COUNTERCLAIMANT STUDIO MODERNA
SA TO AMENDED CONSOLIDATED
NOTICE OF OPPOSITION AND
PETITION TO CANCEL**

Applicant Studio Moderna SA ("Studio Moderna" or "Applicant") hereby answers the Amended Consolidated Notice of Opposition and Petition to Cancel filed by Arcadia Group Brands Ltd. ("Arcadia" or "Opposer") as follows, wherein numbered paragraphs correspond to like numbered paragraphs in the Notice of Opposition. Pursuant to the Board Order of August

13, 2010, the first Amended Consolidated Notice of Opposition and Petition to Cancel filed April 30, 2009 is the operative document in these proceedings.

As to an initial unnumbered paragraph, Applicant acknowledges Opposer's representation as to its address and incorporation but has insufficient information upon which to form a belief as to the truth of the representations and therefore denies the same. Applicant admits that it has an address in Lugano, Switzerland (currently Via Ferruccio Pelli 13, 6900 Lugano, Switzerland). Applicant denies that Opposer has been or is likely to be damaged by the registration of Applicant's U.S. Application Serial No. 78/239,078. Applicant denies that Petitioner has been or is likely to be damaged by Applicant's U.S. Registration No. 3,389,652.

1. Applicant denies that the "Topshop" stores, web sites or products are "internationally renowned." Applicant denies that Opposer's "Topshop" marks are "famous." Applicant denies that consumers in the United States and worldwide "have long had familiarity" with Opposer's "Topshop" marks. Applicant denies that consumers in the United States and worldwide associate "Topshop" with Opposer. Applicant denies that Opposer has used "Topshop" consistently in the United States since 1998. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 1 and therefore denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 and therefore denies the same.

3. Applicant denies that all of Opposer's Topshop names and marks are valid. Applicant denies that all of Opposer's Topshop names and marks cover retail store services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 3 and therefore denies the same.

4. Applicant admits that U.S. Registration No. 3,237,860 lists Arcadia Group Brands Limited as the Registrant of Topshop in International Class 25 and that the remaining recital of that document is as set forth therein.

5. Applicant admits that U.S. Registration No. 3,524,208 lists Arcadia Group Brands Limited as the Registrant of Top Shop in International Class 14 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer's mark registered as U.S. Registration No. 3,524,208 is entitled to priority based upon U.K. Reg. No. 1,522,280.

6. Applicant admits that U.S. Registration No. 3,524,207 lists Arcadia Group Brands Limited as the Registrant of Top Shop in International Class 9 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer's mark registered as U.S. Registration No. 3,524,207 is entitled to priority based upon U.K. Reg. No. 1,522,759.

7. Applicant admits that U.S. Registration No. 3,552,730 lists Arcadia Group Brands Limited as the Registrant of Topshop in International Class 18 and that the remaining recital of that document is as set forth therein.

8. Applicant admits that U.S. Application Serial No. 78/631,860 lists Arcadia Group Brands Limited as the Applicant for registration of Top Shop in International Class 35 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer has used "Topshop" consistently in the United States since 1998. Applicant denies that Arcadia has earlier use of "Topshop" in the United States. Applicant denies that Arcadia is entitled to registration of "Topshop" and denies the remaining allegations of paragraph 8.

9. Applicant denies that Opposer has used "Topshop" consistently in the United States since 1998. Applicant denies the remaining allegations of paragraph 9.

10. Applicant admits that it filed a Statement of Use in connection with the application that matured into U.S. Registration No. 3,389,652 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer has used "Topshop" consistently in the United States since 1998. Applicant denies that Arcadia's "Topshop" name is well-known among United States consumers. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 10 and therefore denies the same.

11. Pursuant to the Board Order dated August 13, 2010, paragraph 11 has been stricken from Arcadia's Amended Consolidated Notice of Opposition and Petition to Cancel.

12. Pursuant to the Board Order dated August 13, 2010, paragraph 12 has been stricken from Arcadia's Amended Consolidated Notice of Opposition and Petition to Cancel.

13. Pursuant to the Board Order dated August 13, 2010, paragraph 13 has been stricken from Arcadia's Amended Consolidated Notice of Opposition and Petition to Cancel.

14. Applicant denies there is any likelihood of confusion, mistake or deception in the minds of the purchasing public between Applicant's services and Arcadia's services. Applicant denies that Opposer owns a Topshop "Family of Marks." Applicant denies that Arcadia has earlier use of "Topshop" in the United States. Applicant denies that Arcadia's "Topshop" mark has developed secondary meaning. Applicant denies the remaining allegations of paragraph 14.

15. Applicant admits that it filed Application Serial No. 77/405,680 on February 25, 2008 seeking registration of the mark TOP SHOP in Classes 35, 38 and 41 ("680 Application"). Applicant admits that it filed a Request to Divide the '680 Application on August 29, 2008, which divided out Classes 38 and 41 into Application Serial No. 77/975,981. Applicant admits the recitation of services recited therein. Applicant denies that Opposer has used "Topshop"

consistently in the United States since 1998. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegation regarding Arcadia's "flagship store" and therefore denies the same. Applicant denies the remaining allegations paragraph 15.

16. Applicant denies the allegations of paragraph 16.

17. Applicant denies the allegations of paragraph 17.

18. Pursuant to the Board Order dated August 13, 2010, paragraph 18 has been stricken from Arcadia's Amended Consolidated Notice of Opposition and Petition to Cancel.

19. Applicant admits that U.S. Application Serial No. 78/239,078 claims a filing basis under Section 44(e) of the Lanham Act. Applicant admits the recital of that statutory provision as set forth therein. Applicant denies the remaining allegations of paragraph 19.

20. Applicant denies the allegations of paragraph 20.

As to a final unnumbered paragraph, Applicant acknowledges Opposer's requests but denies that Opposer is likely to be damaged by U.S. Registration No. 3,389,652 or U.S. Application Serial No. 78/239,078. Applicant denies that U.S. Application Serial No. 78/239,078 should be refused registration. Applicant denies that U.S. Registration No. 3,389,652 should be canceled.

AFFIRMATIVE DEFENSES

21. Opposer's requested relief should be denied based upon failure to state a claim.

22. Opposer's requested relief should be denied as its claims are barred due to unclean hands.

23. Opposer's requested relief should be denied for lack of priority over Applicant's pre-existing TOP SHOP and TOP SHOP TV registrations, and for the reasons stated in the

Counterclaims set forth below, Opposer may not base a claim of priority on U.S. Registration No. 3,237,860.

COUNTERCLAIMS

24. Applicant-Counterclaimant Studio Moderna SA ("Applicant"), a company organized and existing under the laws of Switzerland and having a place of business in Lugano, Switzerland, is a major retailer that does business in many countries throughout the world selling various consumer products in more than 100 physical stores, on television and on the Internet. Applicant owns trademark registrations covering its TOP SHOP and TOP SHOP TV trademarks in more than 44 countries, including, *inter alia*, the European Community, the United States, and Switzerland.

25. Applicant is the owner of U.S. Registration No. 3,389,652, the application for which was filed October 14, 2002 and issued February 26, 2008, for the mark TOP SHOP TV for "on-line retail services in the field of general consumer merchandise" in International Class 35. This registration is the subject of Cancellation No. 92049146, initiated by Arcadia Group Brands Ltd. ("Arcadia" or Registrant").

26. Applicant is the owner of U.S. Application Serial No. 78/239,078, filed April 17, 2003, for the mark TOP SHOP TV (and design) for goods and services in Classes 10, 20, 24, 35 and 41. This application was published for opposition on August 23, 2005 and is the subject of Opposition No. 91169226, initiated by Arcadia.

27. Applicant is the owner of U.S. Application Serial No. 79/054,176, filed November 2, 2007, for the mark TOP SHOP for services in Classes 38 and 39. This application was published for opposition on March 17, 2009 and is the subject of Opposition No. 91191087, initiated by Arcadia.

28. Applicant is the owner of U.S. Application Serial No. 77/975,980, filed February 25, 2008, for the mark TOP SHOP TV for services in Classes 38 and 41. This application was published for opposition on March 3, 2009 and is the subject of Opposition No. 91190739, initiated by Arcadia.

Arcadia and Nevada Apparel's TOPSHOP Mark

29. On December 2, 2002, a company called Nevada Apparel Corp. ("Nevada Apparel") filed Application Serial No. 78/190,311 under Section 1(b) of the Lanham Act to register the mark TOPSHOP in Class 25 ("Nevada Apparel ITU Application").

30. On October 31, 2005, Arcadia filed a Notice of Opposition against the Nevada Apparel ITU Application. On May 24, 2006, Nevada Apparel filed a Complaint for unfair competition against Arcadia in the U.S. District Court for the Southern District of New York ("New York Lawsuit")

31. Thereafter: (a) on August 28, 2006, Arcadia entered into an Assignment with Nevada Apparel purporting to assign the Nevada Apparel ITU Application and the goodwill associated therewith; (b) on August 29, 2006, Arcadia filed a Stipulation of Withdrawal of Arcadia's Opposition to Nevada Apparel ITU Application wherein Arcadia and Nevada Apparel stipulated to such withdrawal "with all right, title and interest in and to the subject application, and to the mark set forth in the application, and the goodwill associated therewith, being concurrently assigned by" Nevada Apparel to Arcadia; and (c) on August 31, 2006, Arcadia and Nevada Apparel filed a Consent Injunction Submitted and Stipulation of Dismissal (the "Consent Injunction") in the New York Lawsuit. True and correct copies of the Assignment, the Stipulation of Withdrawal, and the Consent Injunction are attached hereto as Exhibits 1, 2, and 3, respectively.

32. The Assignment, the Stipulation of Withdrawal, and the Consent Injunction do not purport to transfer Nevada Apparel's ongoing and existing Topshop business to Arcadia. Based on Arcadia's discovery responses in pending Opposition No. 91169226, Studio Moderna is informed and believes, and based thereupon alleges, that Nevada Apparel did not transfer that business to Arcadia at the time it assigned the Nevada Apparel ITU Application to Arcadia.

33. The Notice of Allowance issued on November 21, 2006. A Statement of Use was filed by Arcadia on November 30, 2006, approximately three months after the purported Assignment to Arcadia.

FIRST COUNTERCLAIM: CANCELLATION OF U.S. REGISTRATION NO. 3,237,860 FOR ASSIGNMENT IN VIOLATION OF 15 U.S.C. § 1060(a)

34. The allegations of paragraphs 1-33 of Applicant's Answer and Counterclaims are re-alleged and incorporated by reference as if fully set forth here.

35. Studio Moderna is informed and believes, and based thereupon alleges, that Nevada Apparel did not transfer its ongoing and existing Topshop business in connection with the purported assignment of the Nevada Apparel ITU Application prior to the filing of the Statement of Use, and that the purported assignment of the Nevada Apparel ITU Application therefore violated 15 U.S.C. § 1060(a)(1) and invalidated the registration.

36. Studio Moderna will be damaged by continued registration of the mark shown in Registration No. 3,237,860 because that mark has been asserted against Studio Moderna in Arcadia's Opposition.

37. Accordingly, Arcadia's Registration No. 3,237,860 should be canceled based upon the invalidity of the purported assignment of the Nevada Apparel ITU Application.

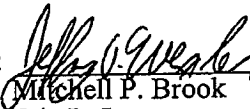
WHEREFORE, having fully answered, Applicant Studio Moderna requests that the present Notice of Opposition be dismissed with prejudice; that Studio Moderna be granted registration for the mark applied for; that the present Petition to Cancel be denied with prejudice; and that the Petition for Cancellation against Opposer/Counterclaim Registrant Arcadia Group Brands be granted and Trademark Registration No. 3,237,860 be canceled.

Please address all correspondence to Mitchell P. Brook, Esq., c/o Luce, Forward, Hamilton & Scripps LLP, 600 West Broadway, Suite 2600, San Diego, California 92101.

Dated: September 7, 2010

Respectfully submitted,

By:



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Counterclaimant Studio Moderna SA

CERTIFICATE OF SERVICE

I hereby certify that I served a true copy of the foregoing **ANSWER AND COUNTERCLAIMS BY APPLICANT-REGISTRANT AND COUNTERCLAIMANT STUDIO MODERNA SA TO AMENDED CONSOLIDATED NOTICE OF OPPOSITION AND PETITION TO CANCEL** to the following attorneys via U.S. mail at the postal address set forth below.

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Date: September 7, 2010

Signature: /s/ Eric L. Lane
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